

REMARKS

Status of the Claims

Claims 1-44 are pending. Claims 11, 19, 35, and 36 have been cancelled. Claim 1 has been amended to more particularly point out and distinctly claim that which Applicants regard as their invention. Claim 1 has been amended to recite "alkyl groups having from 1 to 18 carbon atoms" as per the Examiner's suggestion in the November 12, 2002 interview. Support for this amendment can be found in the originally filed disclosure. (See Specification, page 11, lines 7-8). This amendment is not intended to narrow the scope of the claims. Accordingly no new matter is added by this amendment.

Claim 1 has also been amended to recite that the cosmetic composition further comprises "at least one cationic polymer and at least one silicone." Support for this amendment can be found in the originally filed disclosure (See Specification, page 12, line 3 to page 26, line 18; page 26, line 19 to page 35, line 1; page 40). Accordingly, no new matter is added by this amendment.

Interview

Applicants wish to thank Examiner Willis and Examiner Padmanabhan for granting Applicants' representatives, Brian Burn and Matt Mason, the courtesy of an interview conducted November 12, 2002. During this interview, Applicants' representatives discussed with the Examiner the rejections under 35 U.S.C. § 112 and § 103. Specifically, Applicants explained that the references failed to teach or suggest the substitution of CEPA Starch for Carbopol® so as to obtain Applicants' claimed

composition. Applicants also explained that the pending claims are definite, especially when read in view of the specification.

Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 1-12, 14, 16-22, and 30-36 have been rejected under 35 U.S.C. § 112, second paragraph, for allegedly failing to particularly point out and distinctly claim that which Applicants regard as the invention. Applicants respectfully request the removal of these rejections in view of the amendment above and the discussion below.

Claims 1, 35, and 36 are rejected due to the definition of R" as "chosen from a hydrogen atom and alkyl groups comprising 1 to 18 carbon atoms." According to the Examiner, "the rejection is maintained because it is ambiguous whether or not a chain of 19 carbon atoms is encompassed by the definition of R". (Final Office Action, page 3). Without acquiescing to this rejection, Applicants note that claims 35 and 36 have been withdrawn. Applicants further note that claim 1 has been amended to recite "chosen from a hydrogen atom and alkyl groups having from 1 to 18 carbon atoms" as was discussed during the November 12, 2002, interview. While emphasizing that the scope and substantive meaning of this claim remains unchanged by this substitution in terms, Applicants respectfully submit that the claim, as amended, sets forth the subject matter so as to reasonably apprise those skilled in the art of the scope of the invention. See MPEP § 2173.02. Accordingly, Applicants respectfully request the withdrawal of this rejection.

Claim 33 has been rejected for allegedly "being confusing by including fatty acids where independent Claim 1 states the proviso that the compositions be free of fatty acid

soaps.” (Final Office Action, page 3). According to the Examiner, “[w]hen a fatty acid is added to a composition containing an alkali metal or alkaline-earth metal, it would necessarily form at least some amount of fatty acid soap.” *Id.*

Applicants respectfully traverse this rejection by referring the Examiner to the specification, which states: “As used herein, the expression ‘free of fatty acid soaps’ means that fatty acid soaps are present in an amount ranging for example from 0% to 1% by weight, such as from 0% to 0.1% by weight, relative to the total weight of the final composition.” (Specification, page 3, lines 19-21). While this disclosure in no way limits the scope of Applicants’ claims, it does reasonably apprise those skilled in the art the meaning of the terms “free of fatty acid soaps.” In view of this disclosure, Applicants respectfully submit that no inherent inconsistency exists between claims 1 and 33, as discussed during the November 12, 2002, interview. Applicants also refer the Examiner to the interview summary in which the Examiner noted that “[f]ree of fatty acids’ will be favorably reconsidered in view of specification, page 3.” Accordingly, Applicants respectfully request the withdrawal of this rejection.

Rejections Under 35 U.S.C. § 103

Claims 1-10, 19-22, 30-32, and 35-36 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,001,344 to Villa et al. (“Villa”) in view of U.S. Patent No. 5,482,704 to Sweger et al. (“Sweger”). According to the Examiner, Example II of Sweger provides motivation to substitute CEPA-starch, as taught in Sweger, for Carbopol® as disclosed in Villa. Applicants disagree.

Citing *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981), the Examiner states that the test for obviousness "is what the combined teachings of the references would have suggested to those of ordinary skill in the art." (Final Office Action, page 5). Applicants do not disagree that obviousness is determined by examining the teachings of the prior art in their entirety. As stated in the MPEP, "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." MPEP § 2141.02 (emphasis in original) (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)). Here, when the prior art references are considered in their entirety, there is no motivation to make the substitution proposed by the Examiner. Hence, no prima facie case of obviousness has been established.

Here, the substitution proposed by the Examiner would render the prior art invention being modified unsatisfactory for its intended purpose. "If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01 (citing *In re Gordon*, 773 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

Here, the substitution of CEPA- starch for Carbopol® would render Villa unsatisfactory for its intended purpose. Villa states that:

Suddenly and unexpectedly, applicants have found that when xanthan gum and cross-linked polyacrylic acid polymer saturated compounds (e.g., polyacrylate or polymethacrylate) are used in the specified surfactant system of the invention, they stably suspend large benefit agent particles. **By contrast, when xanthan gum or**

cross-linked polyacrylic acid polymer is used alone, the benefit agent cannot be suspended without separation.

(Villa, col. 1, line 65 to col. 2, line 5 (emphasis added)). Thus, Villa discloses that when xanthan gum is used alone (i.e. Carbopol® is absent), the essential and unexpected aspect of the invention, the suspension of large benefit agent particles, cannot be achieved. Hence, the presence of Carbopol® is essential for the practice of Villa's invention and its removal would make Villa unsatisfactory for its intended purpose. Accordingly, for this reason alone, the § 103(a) rejection over Villa in view of Sweger should be withdrawn.

In addition, as Applicants have previously emphasized, Example II of Sweger does not support the Examiner's assertion that Sweger teaches that "CEPA-starch is superior to Carbopol®." In that example, Sample A contained four times as much CEPA-Starch as Control 2 contained Carbopol®. Given the differences in concentration between CEPA-Starch and Carbopol® in Example II, as well as other differences in those compositions, Applicants maintain that Sweger's conclusions regarding CEPA-starch and Carbopol® do not extend beyond the limited conditions of that example and certainly cannot be extrapolated to other compositions not even disclosed or suggested by Sweger. Thus, for this additional reason, the rejection over Villa in view of Sweger should be withdrawn.

Finally, Applicants note that claim 1 has been amended to recite that the composition further comprises "at least one cationic polymer and at least one silicone." In view of this amendment, Applicants respectfully submit that the combination of cited references fails to teach or suggest Applicants' claimed invention.

Claims 1-12, 14, 16-18, and 35-36 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,720,964 to Murray in view of Sweger. As with the rejection over Villa in view of Sweger, Applicants maintain that the Examiner has failed to establish a prima facie case of obviousness. Specifically, Applicants emphasize that Example II of Sweger does not provide the requisite motivation to substitute CEPA-Starch for Carbopol® in compositions disclosed in Murray. In addition, Murray teaches that Carbopol® is used in his disclosed compositions as a "silicone suspending agent." (Murray, col. 4, lines 38-58). Neither reference teaches or suggests that any of the amphoteric starches disclosed in Sweger would likewise serve as a suitable "silicone suspending agent" as required by Murray. Thus, the references fail to teach or suggest the substitution proposed by the Examiner. Accordingly, Applicants respectfully request that the rejection over Murray in view of Sweger be withdrawn.

Finally, Applicants note that claim 1 has been amended to recite that the composition further comprises "at least one cationic polymer and at least one silicone." Thus, for at least this additional reason and those discussed above, Applicants respectfully submit that the combination of cited references fails to teach or suggest Applicants' claimed invention.

Claims 1 and 33-34 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,919,438 to Saint-Leger in view of Sweger. As with the other rejections discussed above, Applicants maintain that the Examiner has failed to establish a prima facie case of obviousness. Specifically, Applicants emphasize that Example II of Sweger does not provide the requisite motivation to substitute CEPA-

Starch for Carbopol® in compositions disclosed in Saint-Leger. In addition, Saint-Leger fails to teach or suggest a detergent and conditioning composition containing Carbopol®.

Example 4 of Saint-Leger merely teaches a spray for the scalp, used in preventing hair loss. In order to obtain a detergent or conditioning composition containing Carbopol®, a person of ordinary skill in the art would be required to pick and choose from among the many ingredients disclosed in Saint-Leger's various examples. A person of ordinary skill in the art would be further required to substitute CEPA Starch for Carbopol®, despite the fact that neither reference teaches or suggests making such a substitution.

Finally, Applicants note that claim 1 has been amended to recite that the composition further comprises "at least one cationic polymer and at least one silicone." In view of this amendment, and the arguments provided above, Applicants respectfully submit that the combination of cited references fails to teach or suggest Applicants' claimed invention.

In view of the foregoing remarks, Applicants respectfully request the reconsideration of this application and submit that all pending claims are in a condition for allowance.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.


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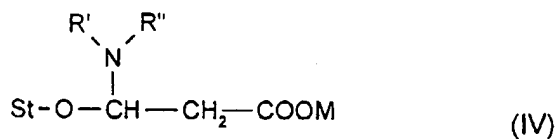
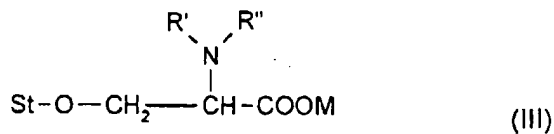
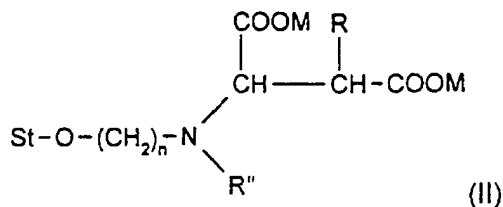
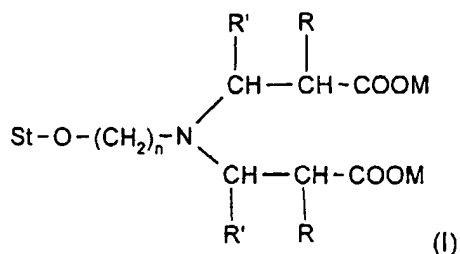
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APPENDIX

In accordance with 37 C.F.R. §1.121(b) and (c), Applicants set forth claims 1, 12, 16, 20, and 31 in marked up form. Underlined text indicates additions to the claim, and [square brackets] enclose deletions.

Claims

1. (Amended) A cosmetic composition comprising, in a cosmetically acceptable aqueous medium, a washing base and at least one amphoteric starch chosen from the compounds of formulae (I) to (IV):



wherein:

-St-O is a starch moiety;

-R, which may be identical or different, are each chosen from a hydrogen atom and a methyl group;

-R', which may be identical or different, are each chosen from a hydrogen atom, a methyl group, and a -COOH group;

-n is chosen from integers ranging from 2 to 3;

-M, which may be identical or different, are each chosen from a hydrogen atom, an alkali metal, an alkaline-earth metal, NH₄, quaternary ammonium compounds, and organic amines; and

R'', which may be identical or different, are each chosen from a hydrogen atom and alkyl groups [comprising] having from 1 to 18 carbon atoms,

wherein said composition is a detergent and conditioning composition further comprising at least one cationic polymer and at least one silicone, and wherein said composition is free of fatty acid soaps.

12. (Amended) A composition according to claim [11] 1, wherein said at least one cationic polymer is chosen from quaternary cellulose ether derivatives, cationic cyclopolymers, cationic polysaccharides, quaternary polymers of vinylpyrrolidone and quaternary polymers of vinylimidazole.

16 (Amended) A composition according to claim [11] 1, wherein said at least one cationic polymer is present in an amount ranging from 0.001% to 10% by weight, relative to the total weight of the composition.

20. (Amended) A composition according to claim [19] 1, wherein said at least one silicone is chosen from non-volatile polyorganosiloxanes.

31. (Amended) A composition according to claim [19] 1, wherein said at least one silicone is present in an amount ranging from 0.001% to 20% by weight, relative to the total weight of the composition.